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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,815	10/21/2005	Sumit Roy	3651-1025	6741
<small>465</small> YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314			<small>7590</small> 02/12/2009	
EXAMINER				
SONNETT, KATHLEEN C				
ART UNIT		PAPER NUMBER		
3731				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/522,815

Applicant(s)

ROY ET AL.

Examiner

KATHLEEN SONNETT

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-30 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-30 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 20-30, 33, and 34** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims that the fingers are of uniform thickness. However, there is no disclosure in the specification or figures to support a limitation of fingers made of material with a uniform thickness. Although the cross section shows the finger is relatively the same thickness where the cross-section was taken, this doesn't mean that each of the fingers could not be thicker at locations circumferentially offset of the place where the cross section was taken.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 20-25, 30, and 33-35** are rejected under 35 U.S.C. 102(b) as being anticipated by Bloomer (US 2,537,183). Bloomer discloses a device capable of interconnecting a first and

second organ comprising a first element (10) with an axially through-going first passage along a first longitudinal axis and a first front end portion, a first front edge, a first rear end portion, and a first rear edge and a second element (3,4,5) with an axially through-going second passage along a second longitudinal axis, a second rear end portion or receiving portion, and a second front portion wherein the second front portion is provided with at least two elongated first fingers (4,5) which are arranged at intervals along the circumference of the first passage and the fingers are of uniform thickness, each of the fingers comprising a main portion (4) extending from the second front portion and in the direction of the second longitudinal axis and the main portion is continuous with a gripping part (5), wherein the gripping part is directed away from the second longitudinal axis in an undeformed condition of the second element such that introduction of the first element into the second element displaces the main portions of the fingers radially outwards (see fig. 1-4).

5. Regarding claim 21, it is noted that any of the other fingers can be considered the additional, second finger and this finger is capable of abutting an outside surface of the second organ when the gripping parts have been inserted in the second organ. That is to say, the second finger is capable of being bent up so that it remains outside the organ while the other fingers are inserted into the organ.

6. Regarding claim 22, see fig. 1 which that the main portions of the finger shave a radially outward convex configuration.

7. Regarding claim 23, the second element is provided with an annular collar movable longitudinally along the outer surface of the second element (for example "6").

8. Regarding claim 24, the finger is provided with a shoulder which protrudes radially outward from the finger such that the shoulder restricts mobility of the annular collar. The shoulder may be considered the outward-most half of portions (5).

9. Regarding claim 25, the first element is provided with an external sleeve-shaped casing (7 and 8) with a front end, the casing being continuous with the first element at the first rear edge such that the casing and the first element define a cylindrical annulus that stops short of the front end of the first element. For example, the annulus can be considered the distal end of element (8) which forms a ring.
10. Regarding claim 30, the front edge of the first element defines a first plane and the gripping parts define a second plane, such that the first plane and the second plane form the same angle with the longitudinal axes of the first and second element when the first element is optimally inserted into the second element. The first and second planes are both perpendicular to the longitudinal axes.
11. Regarding claims 33 and 34, see fig. 1-4.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claim 26** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomer in view of Hart (US 1,339,620). Bloomer discloses the invention substantially as stated above but fails to disclose that the second element (3) includes an outwardly projecting pin that engages a slot formed in the casing (7) when the first element is inserted into the second element. Hart teaches that it is old and well known to lock an inner and outer member using a pin formed on the inner member and a slot formed on an outer member (see fig. 1). It would have been obvious to one skilled in the art to substitute such a pin and slot configuration as taught by Hart for the

threading connection of Bloomer as one skilled in the art has good reason to pursue the known options within his or her technical grasp including different methods of locking an inner and outer member together. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill in the art. The pin and slot engage each other when the first element is inserted into the second element since the casing (7) and the second element may already be engaged with each other.

14. **Claim 27** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomer in view of Defauw (US 3,358,357). Bloomer discloses the invention substantially as stated above but fails to disclose a shoulder on the first element that abuts against the rear end portion of the second element during insertion of the first element into the second element. However, Defauw discloses that it is old and well known to provide a flange (6) on the end of a tubular member inserted into the orifice of another member in order to prevent the inner member from being inserted further than its ideal position (col. 3 ll. 50-53). It would have been obvious to one skilled in the art to have modified Bloomer to include a flange on the rear end of the first element (10) that abuts the first element (such as against portion 7 which can be considered part of the second element (3) for claim 27) as taught by Defauw in order to ensure that element (10) is properly positioned within element (3).

15. **Claim 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomer in view of Haury (US 2,211,776). Bloomer discloses the invention substantially as stated above but fails to disclose that either of the first or second elements is perforated. Haury teaches that it is old and well known to include perforations on an inner tubular member into which portions of the outer tubular member protrude (figs. 2, 3; col. 1 ll. 20-30). Such a configuration allows for a strong, non-separable fluid-tight coupling. It would have been obvious to add such perforations

on the inner member (10) of Bloomer as well as protrusions on the outer member (3) which fit therein as taught by Haury in order to strengthen the coupling.

16. **Claim 29** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomer in view of Frost (US 3,228,713). Bloomer discloses the invention substantially as stated above but fails to disclose a flared end on the second element. However, as taught by Frost and as is well known in the art, a flared end allows easier insertion of one tubular member inside of another (see figs. 4-6). It would have been well within the purview of one skilled in the art to have flared the end of the second element of Bloomer to facilitate insertion of the first element (10) within the second element (3).

Response to Arguments

17. Applicant's arguments filed 11/12/2008 have been fully considered but they are not persuasive. Applicant's argument that, because Bloomer includes additional elements from those claimed in claims 20, 30, and 33-35, the prior art of Bloomer does not anticipated the claimed invention is not found persuasive. The prior art of Bloomer includes all of the claimed structure of claims 20, 30, and 33-35 and is capable of connecting a first organ to a second organ. Each of these claims includes the transitional phrase "comprising", which is inclusive or open-ended and does not exclude additional, unrecited elements or method steps (see MPEP 2111.03: The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., > Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369,1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended.").< Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates

that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts"). >In *Gillette Co. v. Energizer Holdings Inc.*, 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005), the court held that a claim to "a safety razor blade unit comprising a guard, a cap, and a group of first, second, and third blades" encompasses razors with more than three blades because the transitional phrase "comprising" in the preamble and the phrase "group of" are presumptively open-ended. "The word comprising' transitioning from the preamble to the body signals that the entire claim is presumptively open-ended." *Id.* In contrast, the court noted the phrase "group consisting of" is a closed term, which is often used in claim drafting to signal a "Markush group" that is by its nature closed. *Id.*)

18. Applicant's arguments regarding the 35 USC 112 1st paragraph rejection of claims 20-30, 33, and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, are not found persuasive. Applicant claims that the fingers are of uniform thickness. However, there is no disclosure in the specification or figures to support a limitation of fingers made of material with a uniform thickness. Although the cross section shows the finger is relatively the same thickness where the cross-section was taken, this doesn't mean that each of the fingers could not be thicker at locations circumferentially offset of the place where the cross section was taken.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHLEEN SONNETT whose telephone number is (571)272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCS 2/9/2009

/Anh Tuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731